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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,055	07/21/2005	Koji Kodama	Q89305	5687
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WASHINGTON, DC 20037-3213				
EXAMINER				
FIORTO, JAMES				
ART UNIT		PAPER NUMBER		
1793				
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12/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/543,055

**Applicant(s)**

KODAMA ET AL.

**Examiner**

JAMES FIORITO

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7,11-16,18-21,23-27,29-32 and 35-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-3,5-7,11-16,18-21,23-27,29-32 and 35-43 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 11-16, 18-21, 23-27, 29-32, and 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imanishi US 2004/0116578 in view of Oishi US 6676920.

Imanishi teaches a process of making granular inorganic filler to be used in resin compositions. The inorganic filler comprises silica and magnesium hydroxide used alone or in combination (Paragraph 26). To enhance the affinity of the inorganic filler with the resin the filler may be treated with stearic acid, magnesium stearate, or silane coupling agents (Paragraph 27). The filler may also be treated with wetting agents such as silicone oil to enhance the kneading property of the resin (Paragraph 31).

Imanishi does not expressly state that the magnesium hydroxide is formed from a reaction of a magnesium salt and a metal hydroxide or that the magnesium hydroxide is surface treated simultaneously with its synthesis.

Oishi teaches a process of making magnesium hydroxide as filler for flame retardant resin compositions (Abstract). Magnesium hydroxide is made by reacting magnesium chloride with sodium hydroxide at room temperature (Example 1).

At the time of invention it would have been obvious to a person of ordinary skill in the art to form the process of Imanishi including the magnesium hydroxide is formed from a reaction of a magnesium salt and a metal hydroxide with its synthesis in view of the teaching of Oishi. The suggestion or motivation for doing so would have been to provide a means of making the magnesium hydroxide required by the process of Imanishi but not disclosed.

It would also have been obvious to surface treat the particles during the synthesis step, since combining the two steps would not produce any unexpected results over the teaching of Imanishi in view Oishi.

#### ***Response to Arguments***

Applicant's arguments filed 9/19/08 have been fully considered but they are not persuasive.

Applicant argues that there is not an objective reason for combining Imanishi and Oishi and that there must be a suggestion or motivation for the combination within the references. In response, the motivation for the combination is found within the primary reference of Imanishi. Imanishi requires magnesium hydroxide to perform the process and because Imanishi does not disclose the process by which the magnesium hydroxide is made, the manner in which the magnesium hydroxide is produced lacks criticality to the invention of Imanishi. Therefore, one of ordinary skill in the art would have been motivated to use any known method of making magnesium hydroxide in the process of Imanishi. Further, in view of *KSR*, the prior art references do not always require express suggestion or motivation. In this case, the making of the magnesium

hydroxide by the reaction of a magnesium salt with a metal hydroxide is among the finite number of possibilities for making magnesium hydroxide acceptable in establishing obviousness under *KSR*.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kiuchi US 2003/0152776 teaches a flame-retardant epoxy resin composition and laminate made with the same. Ihara US 2002/0198303 teaches a flame-retardant resin composition free from halogen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. FIORITO whose telephone number is (571)272-7426. The examiner can normally be reached on 9am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A Fiorito/  
Examiner, Art Unit 1793

/Wayne Langel/  
Primary Examiner, Art Unit 1793